

This Opinion is not a  
Precedent of the TTAB

Mailed: May 15, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Buchanan*

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Serial No. 86847785

Phillip Thomas Horton of The Law Office of Phillip Thomas Horton  
for Gerald Buchanan.

Alex Seong Keam, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.

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Before Wellington, Goodman and Heasley,  
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Gerald Buchanan (“Applicant”) seeks registration on the Principal Register of the  
mark KOPI CHAM MOCHA (in standard characters) for “coffee based beverages”  
in International Class 30.<sup>1</sup>

<sup>1</sup> Application Serial No. 86847785 was filed on December 14, 2015, based upon applicant’s  
allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the  
Trademark Act. “Mocha” is disclaimed.

Page references herein to the application record refer to the online version of the USPTO’s  
Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions  
and orders on appeal refer to the Board’s TTABVUE docket system.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1), 15 U.S.C. § 1052(e)(1). When the refusal was made final, Applicant appealed and requested reconsideration.<sup>2</sup> After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

#### I. Preliminary evidentiary issue

Before turning to the substantive grounds for refusal, we note that Applicant submitted third-party registrations with his brief. These registrations were not previously submitted during prosecution of the involved application and ordinarily will not be considered. Trademark Rule 2.142(d). However, the Examining Attorney did not object to the late-filed evidence, and treated the registrations as being of record in the Examining Attorney's brief. Accordingly, the third-party registrations submitted with Applicant's brief have been considered. *In re Litehouse Inc.*, 82 USPQ2d 1471, 1475 n.2 (TTAB 2007) (third-party registrations submitted for first time with applicant's appeal brief considered because examining attorney did not object in her brief and instead presented arguments in rebuttal of this evidence).

#### II. Arguments

The Examining Attorney maintains that the term KOPI CHAM MOCHA is merely descriptive of Applicant's coffee-based beverages because the goods may be mocha flavored "kopi cham," which is coffee mixed with tea as the term is used in Malaysia.

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<sup>2</sup> The application was abandoned and revived twice during prosecution.

Applicant contends that the mark is at most suggestive. While acknowledging that the terms are “arguably descriptive in-and-of themselves,” Applicant submits that when combined ... [they] evoke a new, non-descriptive commercial impression, namely coffee products that include tea, and/or chocolate, and/or milk.”<sup>3</sup> Applicant further argues that the combination of the terms creates incongruity by “juxtaposing discordant elements or ideas by combining mocha ingredients with coffee and tea” and requires multi-step reasoning “to arrive at a tolerably accurate understanding of the goods or services being offered in connection with the proposed mark.”<sup>4</sup>

### III. Applicable Law

Section 2(e)(1) of the Trademark Act precludes registration of a mark that, when applied to the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Whether a term is merely descriptive is determined not in the abstract, but “in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because

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<sup>3</sup> 12 TTABVUE 15.

<sup>4</sup> 12 TTABVUE 14, 15.

of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. *See also In re Chamber of Commerce*, 102 USPQ2d at 1219.<sup>5</sup>

We now look at the record to determine if Applicant’s mark is merely descriptive. “The perception of the relevant purchasing public sets the standard for determining descriptiveness. Any competent source suffices to show the relevant purchasing public’s understanding of a contested term or phrase.” *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citations omitted). The Examining attorney relies on several pieces of evidence.

First, the Examining Attorney included definitions of the separate terms “kopi,” “cham” and “mocha” as well as the combined term “kopi cham” from the dictionary and Internet websites. We find the following definitions most probative:

KOPI - “coffee (beverage).”<sup>6</sup>

CHAM - Hokkien (a southern Chinese dialect group) word for “mix.”<sup>7</sup>

KOPI CHAM - a beverage of coffee mixed with tea.<sup>8</sup>

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<sup>5</sup> In its brief, Applicant argues the three-part test based on the Board case *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 USPQ 502 (TTAB 1985). However, that test has been superseded. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016). We base our analysis on the current test of mere descriptiveness as set forth by the Court of Appeals for the Federal Circuit. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

<sup>6</sup> April 4, 2016 Office Action pp. 2-4, Wiktionary, a wiki-based open content dictionary.

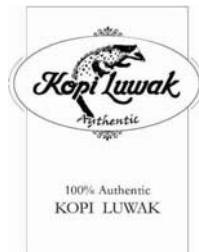
<sup>7</sup> April 4, 2016 Office Action p. 29, (Wikipedia.com), p. 39, (dailycookingquest.com), and p. 61 (tripadvisor.com); September 13, 2017, p. 14 (visiting singapore.com). *See also* April 4, 2016 Office Action, pp. 35-36, discussing “cham.”

<sup>8</sup> April 4, 2016 Office Action, pp. 29, 33, 43, 46. Also known as Yuan Yang tea which is the Chinese name for coffee with tea. *Id.*, at 29, 38.

MOCHA - “a flavoring made of coffee mixed with chocolate” or “a coffee beverage flavored with milk, sugar and cocoa.”<sup>9</sup>

Second, the Examining Attorney introduced two registrations containing the term “kopi.”<sup>10</sup> The Examining Attorney also relies on third-party registrations submitted by Applicant containing the term “mocha.”<sup>11</sup> Third party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry. *See In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006).

The registrations include:



Reg. No. 3982365 for coffee, artificial coffee, coffee flavorings, coffee-based beverages, “Kopi Luwak” disclaimed.<sup>12</sup>



Reg. No. 4904448 for coffee and coffee-based beverages, “Kopi Trading Company” disclaimed.<sup>13</sup>



Reg. No. 5118431 for iced coffee, “Mocha” disclaimed.<sup>14</sup>

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<sup>9</sup> April 4, 2016 Office Action, American Heritage Dictionary of the English Language (5th Ed. 2015), p. 64.

<sup>10</sup> September 13, 2017 Denial of Reconsideration, pp. 2-7.

<sup>11</sup> 12 TTABVUE 18-26.

<sup>12</sup> September 13, 2017 Office Action, pp. 2-4.

<sup>13</sup> September 13, 2017 Office Action, pp. 5-7.

<sup>14</sup> 12 TTABVUE 19.

Reg. No. 5016862 for HO HO MINT MOCHA for coffee-based beverages, “Mint Mocha” disclaimed.<sup>15</sup>



Reg. No. 4691634 for cocoa, coffee and coffee substitutes; instant coffee; prepared cocoa and cocoa-based beverages; prepared coffee and coffee-based beverages, “Coconut” and “Mocha” disclaimed.<sup>16</sup>

Reg. No. 4879610 for AROMA MOCHA for prepared beverages made with espresso and chocolate flavored milk for consumption on or off premise, “Mocha” disclaimed.<sup>17</sup>

Reg. No. 4783596 for MOCHA COLADA, on the Supplemental Register, for coffee-based beverages flavored with chocolate and coconut; non-carbonated, non-alcoholic coffee-based beverages flavored with chocolate and coconut; coffee-based beverages; chocolate based beverages.<sup>18</sup>

Third, the Examining Attorney provided Internet printouts from various websites that show use of the term “Kopi Cham.”

One of our personal favorite drinks from Asia is a simple, yet delicious mix of coffee tea, milk and sugar called Yuanyang. This coffee-tea mix originated in Hong Kong but quickly became popular in many surrounding countries like Malaysia and Singapore, where it is referred to as either yuanyang or kopi cham.<sup>19</sup>

Kopi Cham: Coffee mixed with tea (Pretty similar to HK’s Yuan Yang).<sup>20</sup>

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<sup>15</sup> 12 TTABVUE 21.

<sup>16</sup> 12 TTABVUE 22.

<sup>17</sup> 12 TTABVUE 26.

<sup>18</sup> 12 TTABVUE 20.

<sup>19</sup> April 4, 2016 Office Action, p. 51.

<sup>20</sup> April 4, 2016 Office Action, p. 46; February 7, 2017 Office Action, p. 8.

Kopi Cham (Coffee mixed with Black Tea).<sup>21</sup>

In Malaysia (and Singapore I believe), this drink has a more literal Malay-Fujianese name of kopi cham or mixed coffee.<sup>22</sup>

This decadent coffee/tea beverage from Hong Kong is delicious hot or iced. . . . Malaysia has a similar treat called “Kopi Cham.”<sup>23</sup>

Well, YuanYang (in Chinese) also known as Kopi Cham (Cham means mix) in Malaysia, also a famous beverage in Hong Kong which is made from seven parts of Coffee and three parts of milk tea.<sup>24</sup>

Can't decide if you want coffee or tea to go with your breakfast? Get yourself a warm cup of yuanyang. This much beloved drink is sometimes known as kopi cham – ‘cham’ is the Hokkien word for ‘mix’ and yuanyang is just that. The concoction of milk tea swirled in with a dose of coffee will give you the best of both worlds.<sup>25</sup>

Next time you are at a kopitiam and do not know what to order, here are some pointers: . . . Kopi cham is a mixture of kopi with tea.<sup>26</sup>

A web search later revealed that yuanyang is three parts kopi (Malaysian coffee) and seven parts teh c (sweet tea with evaporated milk) and is also known as kopi cham (“coffee mix.”)<sup>27</sup>

Other names for cofftea ...Kopi cham (Malaysia).<sup>28</sup>

Kopi Cham, a drink of coffee plus tea, commonly served hot or iced in Malaysia.<sup>29</sup>

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<sup>21</sup> April 4, 2016 Office Action, p. 33; February 2, 2017 Office Action, p. 2.

<sup>22</sup> April 4, 2016 Office Action p. 39.

<sup>23</sup> April 4, 2016 Office Action, p. 43; September 13, 2017 Office Action, p. 8.

<sup>24</sup> February 7, 2017 Office Action, p. 14.

<sup>25</sup> September 13, 2017 Office Action p. 14.

<sup>26</sup> February 7, 2017 Office Action, p. 20.

<sup>27</sup> September 13, 2017 Office Action, p. 17.

<sup>28</sup> September 13, 2017 Office Action p. 18.

<sup>29</sup> February 7, 2017 Office Action p. 25.

In starting our analysis, we first consider the applicability of the doctrine of foreign equivalents, where foreign words (in this case “kopi cham”) are translated into English to determine genericness or descriptiveness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). “When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.” *Id.* at 1696, (citing *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975)). See also *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009) (discussing the doctrine of foreign equivalents). As demonstrated by the evidence of record, the term “kopi cham” has entered the English language and would be understood by buyers as naming a type of coffee beverage popular in Malaysia and nearby Asian countries. The uses of the term “kopi cham” on Internet websites read by English speaking consumers clearly indicate that the term stands for a coffee beverage that includes tea and milk; it would be how United States consumers would ask for or refer to this beverage, and it would be so understood by consumers—without translating the words.<sup>30</sup> Therefore, we find the doctrine of foreign equivalents inapplicable in this case.

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<sup>30</sup> “Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark.” *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1835. “Various factors may inform the probative value of a foreign website in any given case, such as whether the website is in English (or has an optional English language version), and whether the nature of the goods or services makes it more or less likely that U.S. consumers will encounter foreign websites in the field in question.” *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017). We find the foreign websites here are probative of the United States consumer’s understanding of the term “kopi cham” in relation to Applicant’s goods. While some of the print-outs from the Internet websites are from Malaysia or about Malaysia or



Next we consider whether the composite term KOPI CHAM MOCHA is merely descriptive. While we must consider whether the mark as a whole is merely descriptive and not just the individual elements, we “may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004). If the combination retains the descriptive significance of the individual parts, the mark as a whole must be considered merely descriptive. *See e.g., In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *see also In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1824 (TTAB 2012) (holding SEMICONDUCTOR LIGHT MATRIX merely descriptive of light and UV curing systems composed primarily of light-emitting diodes for industrial and commercial applications).

The mark Applicant seeks to register, KOPI CHAM MOCHA, is a composite designation consisting of two merely descriptive components, i.e., “kopi cham” and “mocha.” Applicant’s goods are identified as “coffee based beverages.” The record establishes that “kopi cham” is a beverage of coffee mixed with tea and milk. Thus, “kopi cham,” at the very least, is merely descriptive of the type of coffee-based beverage. The record also establishes that “mocha” is a type of flavoring for coffee in which chocolate is added to the coffee. Therefore, this term also is merely descriptive

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Singapore, they are in English and are aimed at United States consumers either in terms of news stories or articles involving coffee, Asian beverages, Asia, or travel stories directed to the reading audience who might travel as tourists to Asia. In addition to English-speaking people exposed to the articles about Malaysia and nearby countries such as Singapore, the term “kopi cham” would have a descriptive meaning to Malaysian and Singaporean people who now live in the United States.

of an ingredient of Applicant's coffee-based beverages, in that they include chocolate flavoring.

We find that combination of these merely descriptive terms into the composite KOPI CHAM MOCHA does not negate the mere descriptiveness of either of them, nor does it create a composite which is unique, incongruous or otherwise inherently distinctive. The composite designation KOPI CHAM MOCHA directly and merely describes a significant feature of Applicant's goods, namely a coffee-based beverage that combines mocha flavored coffee with milk and tea. No imagination or multi-step reasoning is required in order to understand the nature of the goods from consideration of the proposed trademark for them.

In conclusion, we agree with the Examining Attorney that prospective consumers would immediately perceive the term KOPI CHAM MOCHA as describing significant characteristics of the goods in this case.

In his brief, Applicant requests that he be afforded an opportunity to file an amendment to allege use and amend his application to the Supplemental Register if the Board affirms the Section 2(e)(1) refusal. Such a request, which asks that an amendment to the application be considered only after the Board has considered and decided the appeal, is by its terms untimely. The Board lacks the power to re-open the application to allow Applicant to file an amendment to allege use and to propose the amendment to the Examining Attorney. *See* Trademark Rule 2.142(g) ("An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer... or upon order of the Director").

**Decision:** The refusal to register Applicant's mark KOPI CHAM MOCHA is affirmed.